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APPLICATION NO. 09/424,347	FILING DATE 07/18/00	FIRST NAMED INVENTOR ENDOU	ATTORNEY DOCKET NO. 42427
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HM22/0911

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EXAMINER MURPHY, J
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ART UNIT 1545	PAPER NUMBER
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DATE MAILED: 09/11/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/424,347

Applicant(s)

ENDOU ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, Claims 1-15, drawn to a protein with the amino acid sequence of SEQ ID NO: 1, an isolated gene encoding SEQ ID NO: 1, a plasmid, and a host cell.

Group II, , Claims 1-15, drawn to a protein with the amino acid sequence of SEQ ID NO: 2, an isolated gene encoding SEQ ID NO: 2, a plasmid, and a host cell.

Group III, claim 16, drawn to an antibody to a protein with the amino acid sequence of SEQ ID NO: 1.

Group IV, claim 16, drawn to an antibody to a protein with the amino acid sequence of SEQ ID NO: 2.

Group V, claim 17, drawn to a method of screening a compound which modulates organic ion transport activities of the protein with the amino acid sequence of SEQ ID NO: 1.

Group VI, claim 17, drawn to a method of screening a compound which modulates organic ion transport activities of the protein with the amino acid sequence of SEQ ID NO: 2.

The inventions listed as Groups I-VI do not meet the requirements for Unity of Invention or the following reasons:

Groups I-IV are drawn to separate, distinct inventions and are distinguished from each other because the special technical features which define them by chemical and physical characteristics i.e. structure/function, as well as biological functions are different and these

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special technical features are not shared by each invention. Since these special technical features are not shared by each product and since the common features do not establish an advance over the prior art, the inventions of Groups I-IV do not form a single inventive concept within the meaning of Rule 13.2

Groups V-VI are drawn to methods different in design and performance, and which do not share the same or a corresponding special technical feature which define the contribution of each invention. The methods of Groups V-VI do not share a corresponding special technical feature because the methods are practiced with materially different process steps for materially different purposes and each method requires different starting materials, process steps and goals. Since these special technical features are not shared by each process, and since the common features do not establish an advance over the prior art, the inventions of Groups V-VI do not form a single inventive concept within the meaning of Rule 13.2.

The invention of Groups I-IV are separate and distinct from the invention of Groups V-VI because the invention of Groups I-IV may be used in other methods than those of Groups V-VI, such as in the production of the protein of interest.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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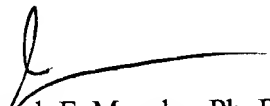
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

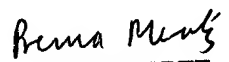
***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
September 7, 2001

  
PREMA MERTZ  
PRIMARY EXAMINER